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09/783,548	02/15/2001	Tomoshige Umeda	202820US3	9370

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EXAMINER	
BASICHAS, ALFRED	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 20

Application Number: 09/783,548
Filing Date: February 15, 2001
Appellant(s): UMEDA ET AL.

J. Derek Mason, Ph.D.
Katherine D. Pauley
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 12, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on December 3, 2003, has been entered. However, applicant has misconstrued the statement in the Advisory Action mailed December 11, 2003, in particular, and the subsequent Advisory Action in general. The statement referred to by applicant is directed to the treatment of the claims in general (i.e., allowed, objected to, rejected, etc.). As the amendment was submitted after final rejection, and prosecution on the merits was closed, no further detail was required; especially since the amendment only added functional language and was given little or no patentable weight. It is for this reason that the examiner did not feel it was necessary to exclude the amendments. Further explanation of the merits of the claimed limitations, real or functional, will be discussed below.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1, 6, 8, 9, and 11-15 stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,205,282	DANESHVAR	4-1993
5,890,486	MITRA	4-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 6, 8, 9, and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daneshvar (5,205,282) in view of Mitra (5,890,486). Daneshvar discloses substantially all of the claimed limitations, such as a mask (figs. 1-3) including a heat/steam generating unit 24, temperature buffer 59 (col. 3, lines 16-24) and inhalation/exhalation valves (figs. 3, 10, and 11). Daneshvar does not specifically recite the heat-generating unit being by exothermic chemical reaction having salt water and metal, and including oxidation. Mitra teaches an apparatus including a heat

generating unit being by exothermic chemical reaction (col. 8, line 45 – col. 9, line 20) having salt water and metal, and including oxidation reaction (col. 9, lines 24-33), so as to provide nasal therapy. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated Mitra's teaching of an apparatus including exothermic chemical reaction having salt water and metal, and including oxidation reaction into the invention disclosed by Daneshvar, so as to provide for nasal therapy.

(11) Response to Argument

Appellant's arguments are mainly focused on the issue of whether the claims are obvious in view of the combination of Daneshvar and Mitra. The main contention being that appellant does not believe that the references are combinable because they are allegedly non-analogous. Appellant also purports that the amended claims are patentable because they were not addressed by the outstanding Final Office Action.

A. As regards appellant's main issue, appellant purports that Daneshvar and Mitra are not analogous because "Daneshvar is directed to a therapeutic nasal inhaler" and "Mitra ... describes a nasal dilator."

i. While general descriptions of the overall inventions are all good and well, the issue remains with what constitutes analogous art. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a

basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, in the least case scenario, the particular problem with which the two references are concerned is the same. Specifically, adequate and efficient "nasal therapy" is the particular problem with which the two references, as well as appellant's invention, are all concerned. Appellant states that this does not provide an adequate motivation, but fails to discuss how.

ii. Appellant further states that the Office Action does not specify how to modify the inventions Daneshvar and Mitra. Yet, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). As such, it would have been obvious to one of ordinary skill in the art faced with the particular problem of providing adequate and efficient nasal therapy to incorporate an element of Mitra beneficial to this particular problem into Daneshvar's invention.

iii. As regards appellant's statement that the amended claim limitations are not addressed by the outstanding Final Office Action, the examiner asserts that the limitations in question were indeed addressed even before

appellant amended the claims to recite them. The Final Office Action specifically stated "applicant's argument that the references fail to show certain features of applicant's invention, ... (i.e., the therapeutic vapor being generated and delivered for inhalation and contact with the nasal passage) are not recited in the rejected claims." Yet, this did not mean that inclusion would constitute allowable subject matter, as explained in the following statement found in the same action.

"In the hopes of expediting prosecution of the instant application, applicant is advised that while functional language is given little or no patentable weight in an apparatus claim, the combination relied upon in the rejection must at least be capable of performing the claimed function."

For the above reasons, it is believed that the rejections should be sustained.

Henry Bennett
Supervisory Patent Examiner
Group 3700

Respectfully submitted,

Alfred Basichas
Primary Examiner
Art Unit 3749

AB
May 3, 2004

Conferees

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